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EXAMINER

CIRIC, LJILJANA V

ART UNIT

PAPER NUMBER

3753

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/614,586

Applicant(s)

ELLIOT ET AL.

Examiner

Ljiljana (Lil) V. Ciric

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 and 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 10, 18, 20-23, 30 and 31 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 26, 2004 has been entered.
2. Claims 1 through 23, 30, and 31 remain in the application, of which all have been amended, either directly or indirectly. Of these, claims 3 through 6 and 11 through 16 remain withdrawn from consideration as noted in greater detail below.

Response to Arguments

1. Applicant's arguments and amendments filed on August 26, 2004 have obviated the objection to the drawings, the new matter objections, and the rejection of claim 31 under 35 U.S.C. 112, first paragraph, and the majority of the rejections of the claims under 35 U.S.C. 112, second paragraph, except as noted in greater detail below in the corresponding section of this Office action.

Applicant's arguments and amendments filed on August 26, 2004 relating to the patentability of amended claim 8 over the Wolf reference have been found persuasive as well.

Otherwise, applicant's arguments filed on August 26, 2004 have been fully considered but they are generally not persuasive except as noted above.

In response to applicant's argument that the Wolf reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that "the first circulation element carrying the heat-carrying fluid **circumscribes** the second circulation element carrying the refrigerant fluid while being in contact with each other") are not recited in

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the rejected claim(s) exactly as such. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As a further note, the examiner wishes to again reiterate that language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure *does not limit the scope of a claim or claim limitation*. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See MPEP 2106. The applicant in the instant application appears to try to rely significantly on exactly the above types of optional language for patentability.

Applicant is furthermore respectfully reminded that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Applicant's arguments with regard to the claims still rejected hereby thus fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims *patentably* distinguishes them from the references.

Applicant's arguments with regard to the claims still rejected hereby thus also do not comply with 37 CFR 1.111(c) because they do not clearly point out the *patentable* novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited

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or the objections made. Further, they do not show how the amendments avoid such references or objections.

Election/Restrictions

2. Claims 3 through 6 and 11 through 16 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to the non-elected second through sixth species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is still no proper antecedent basis in the specification for a heat dissipating fin as recited in claim 31.

Claim Objections

4. Claim 20 is objected to because of the following informalities: "a" immediately preceding "cooling water" and "an" immediately preceding "overcooled water" in line 2 of claim 20 should be deleted; and, "the" should be inserted immediately preceding "cooling water" and "overcooled water" in line 4 of claim 20--all for improved grammatical correctness and readability. Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The limitations "wherein circulation of the refrigerant fluid and circulation of the heat-carrying fluid currents take place *along U-shaped paths opposite to each other*" as recited in claim 10 are still not clear as written, failing to particularly point out and distinctly claim a given structural configuration, and thus further rendering claim 10 indefinite.

Claims 22 and 23 are still rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are, *for example*: the ones between the mixing flap and the main fluid-carrying heat exchanger as recited in each of claims 22 and 23. It is furthermore not clear how the mixing flap cooperates with the main-fluid-carrying heat exchanger in order to restrict airflow therethrough.

Claim Rejections - 35 U.S.C. § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. As best can be understood in view of the indefiniteness of the claims, claims 1, 2, 7, 18, 20, 21, 30, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by *Wolf*.

Wolf discloses a vehicular heating/air conditioning installation essentially as claimed, including, for example: a refrigerating compressor 32, a pressure reducing valve 44, an evaporator 46, and a combined heat exchanger 10 comprising a gas cooler/condenser section 30 and a heating element/radiator section 25 grouped together into a main fluid-carrying heat exchanger 10, where the pressure reducing valve 44 is arranged downstream of the heat exchanger 10. The single heat exchanger or module 10 includes at least one first circulation element such as radiator inlet tank 20 and at least one second circulation element carrying

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element such as condenser section 30, the first circulation element 20 at least partially circumscribing the second circulation element 30 as shown in Figure 3, at least as broadly interpreted as required, and also in contact therewith via header plates 60 and 64. The heat exchanger also includes the various heat transfer surfaces as cited in claims 2 and 7 of the instant application [see Fig. 3, for example]. The examiner hereby reiterates that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." See *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *See In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

The reference thus reads on the claims.

9. The non-application of art against claims 22 and 23 should not be construed as an indication that the claims contain allowable subject matter but rather that the claims could not be examined on the merits due to indefiniteness.

Allowable Subject Matter

10. Claims 8, 9, 17, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (571) 272-4909.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene, can be reached at (571) 272-4930.

lvc

November 26, 2004


LJILJANA V. CIRIC
PRIMARY EXAMINER
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